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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,628	03/10/2000	Frederic Petit	10655.7500	5109

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Snell and Wilmer LLP
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EXAMINER

ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 06/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/522,628

Applicant(s)

PETIT, FREDERIC

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7-9,11,13-16,19,24-27 and 34-37 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1,3,4,7-9,11,13-16,19,24-27 and 34-37 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

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DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.

2. The prior office action dated 11 July 2002, and 30 December 2002 are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- Claims 1, 3, 4, 7-9, 13-16, 19, 24-27, and 34-37 are pending.
- Claim 1 has been amended.
- Examiner withdraws rejection of claims 1, 3, 4, 11, 13-16 under 35 U.S.C. 112-second paragraphs due to amendments by the applicant.
- Additionally the rejection under U.S.C. 102(e) has been withdrawn.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 March 2003 has been entered.

Response to Arguments

Applicant's arguments filed 12 March 2003 have been fully considered but they are not persuasive for the following reasons:

In response to applicant's argument regarding the rejection of claims 1, 19, and 34 examiner respectfully disagrees with applicant. As for the delegated transfer of data by a third party to an end user (i.e. smart card), it is clear by the disclosures of Everett and Davis that such systems do exist and the practice is an obvious variation of transferring of data among different entities. Even the applicant clearly admits to the discloser of the third party being "delegated" to download an application to an IC card by Everett (Applicant's response of 12 March 2003, page 6, lines 3-6).

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As for receiving an "acknowledgement" in form of a token, signature, or any type of verifications in order to certify the success of the transaction is clearly disclosed by Davis (See Davis figures 18A-18C and column 25, lines 20-45 and column 26, lines 36-56). It is clear that an acknowledgment is sent to prove that a transaction has taken place and there is a proof of it.

It is clear that a third party is involved with the transfer of data to an end user that is owned by a first party. Davis clearly shows that data is being exchanged among the three parties and the end user (i.e. Smart card) forwards an "acknowledgement" of such transaction to the owner of the data (i.e. Payment Server). It is clearly demonstrates that how a "success Signature" can be useful in conducting any type of transaction within an smart card to prevent tampering and fictitious reports for updates (i.e. Watchdog for Trusted Electronic Content Distribution, patent no. US 6,219,788). For further clarification, what has been proposed as the claimed invention is an obvious rendition of patching/upgrading of software in a networked environment, this has been performed and practiced within LANs and WANs.

Therefore, the claimed invention as currently presented in this application stands rejected under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 4, 7, 8, 11, 13-16, 19, 24-27, and 34-37, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,317,832 to David Barrington Everett et al. in view of U.S. Patent No. 6,105,008 to Virgil M. Davis et al. and U.S. Patent No. 5,999,740 to David John Rowley.

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5. As per claims 1, 19, and 34, Everett clearly discloses a system for authenticating download of software to an information device, comprising:

- at least one external device capable of transferring the software to said information device over a network (See Everett figures 9 and 10 and associated text and column 3, lines 50-68, and column 4, lines 1-61),
- wherein the software is associated with an information owner remote from said external device, and wherein said software is transferred over a network by said external device as delegated by said information owner (See Everett figures 9 and 10 and associated text and column 3, lines 50-68, column 4, lines 1-61, and column 8, lines 50-68); and
- said information device configured to perform an acknowledgment process (See Everett figures 9 and 10 and associated text and column 3, lines 50-68, column 4, lines 1-61, column 8, lines 50-68, column 9, lines 15-61, and column 12, lines 20-64),

What Everett is not explicit about is the step of forwarding the acknowledgement of the successful download and installation to the information owner. However, Davis clearly teaches the system of securely confirming the download of digital data to a remote information owner by way of a signature (See Davis column 25, lines 20-45, and column 26, lines 36-56). Furthermore, Rowley clearly discloses a system that automatically informs the information owner of the successful download (update) and installation of a software update (See Rowley figures 3A and 3B and associated text, and column 6, lines 13-62). Therefore, it would have been obvious to one of ordinary skill in the art at the time the current invention was made to incorporate the teachings of Everett with the teaching of Rowley and Davis to greatly expand the capability of the Everett's invention for better security, higher level of control, and management of application downloads (Updates).

6. As per claim 3, Everett, Davis, and Rowley disclose all the limitations of claim 1, further; Everett, Rowley, and Davis disclose the claimed invention, as discussed above, except for the step of "verifiable acknowledgment can only be interpreted by said information owner". It would have been an obvious matter of design choice to modify the combined teachings of Everett, Rowley, and Davis, to

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provide the step of “verifiable acknowledgment can only be interpreted by said information owner”, since applicant has not disclosed that solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Everett, Rowley, and Davis will perform the invention as claimed by the applicant with any method, means or product to verify acknowledgment can only be interpreted by said information owner.

7. As per claim 4, Everett, Davis, and Rowley disclose all the limitations of claim 1, further; Davis discloses that the verifiable acknowledgment is a digital signature uniquely related to said transferred software (See Davis column 26, lines 28-68). Therefore, it would have been obvious to one of ordinary skill in the art at the time the current invention was made to incorporate the teachings of Everett with the teaching of Rowley and Davis to greatly expand the capability of the Everett’s invention for better security, higher level of control, and management of application downloads (Updates).

8. As per claims 7, and 8, Everett, Davis, and Rowley disclose all the limitations of claims 1 and 19, further; Everett clearly teaches the fact the information device is a smart card (See Everett figure 10 and associated text and column 2, lines 49-55, and column 14, lines 5-37).

9. As per claim 11, Everett, Davis, and Rowley disclose all the limitations of claim 4, further; Davis discloses that the digital signature is produced using a cryptographic key resident on said information device (See Davis column 5, lines 22-39). Therefore, it would have been obvious to one of ordinary skill in the art at the time the current invention was made to incorporate the teachings of Davis with that of Everett and Rowley to avoid the possibility of the third party being able to look at the content of the signature or token that is forwarded by the smart card to the issuer of the card.

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10. As per claims 13-15 and 24-27, Everett, Davis, and Rowley disclose all the limitations of claims 1 and 19, further;

Everett clearly discloses that,

- software comprises new instructions to be stored on said information device (See Everett column 3, lines 62-68, column 4, lines 1-5, column 9, lines 1-14, and column 14, lines 21-36).
- software is an update of existing instructions stored on said information device (See Everett column 3, lines 62-68, column 4, lines 1-5, column 9, lines 1-14, and column 14, lines 21-36).
- software is a deletion of existing instructions stored on said information device (See Everett column 3, lines 62-68, column 4, lines 1-5, column 9, lines 1-14, and column 14, lines 21-36).

11. As per claim 16, Everett, Davis, and Rowley disclose all the limitations of claim 1, further;

Davis clearly discloses that the software comprises an applet (See Davis column 25, lines 39-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the current invention was made to incorporate the teachings of Davis with that of Everett and Rowley to make the data that is being updated or downloaded to the smart card as an applet, which is a form of data except that is executable on the smart card.

12. As per claims 35-37, Everett, Davis, and Rowley disclose all the limitations of claim 34, further;

Davis clearly discloses

- acknowledgment process utilizes a symmetrical DES algorithm based on said cryptographic key (See Davis column 19, lines 31-68, column 20, lines 1-68, and column 21, lines 1-27).
- DES algorithm is a triple-DES algorithm (See Davis column 19, lines 31-68, column 20, lines 1-68, and column 21, lines 1-27).
- acknowledgment process utilizes a public-key encryption algorithm (See Davis column 19, lines 31-68, column 20, lines 1-68, and column 21, lines 1-27).

Additionally is understood that Everett, Rowley, and Davis disclose the claimed invention, as discussed above, except for the step of utilizing a symmetrical triple DES encryption algorithm using a public key for

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verifications. It would have been an obvious matter of design choice to modify the combined teachings of Everett, Rowley, and Davis, to provide the step of utilizing a symmetrical triple DES encryption algorithm using a public key for verifications, since applicant has not disclosed that solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Everett, Rowley, and Davis will perform the invention as claimed by the applicant with any method, means or product to verify the encrypted acknowledgment .

13. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,317,832 to David Barrington Everett et al. and U.S. Patent No. 5,999,740 to David John Rowley and U.S. Patent No. 6,105,008 to Virgil M. Davis et al. further in view of U.S. Patent No. 6,496,979 to James Chen.

14. As per claim 9, Everett, Davis, and Rowley disclose all the limitations of claim 1, further; Chen clearly discloses a system for updating software and digital information in a personal digital assistant (See Chen column 2, lines 60-68, column 3, lines 25-30, and column 7, lines 34-38). Therefore, it would have been obvious to one of ordinary skill in the art at the time the current invention was made to incorporate the teachings of Chen with the teachings of Everett, Rowley and Davis to greatly expand the capability of the Everett's invention for additional mobile devices such as PDAs besides just limiting the system to the smart cards.

Conclusion

15. The prior art made of record and not relied upon in this office action, and is considered pertinent to applicant's disclosure.

- Patent No. 6,164,549, to Timothy P. Richards, IC Card with Shell Feature
- Patent No. 4,882,474, to Ewald C. Anderl, Security File System and Method for Securing Data In A Portable Data Carrier.

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- Patent No. 6,390,374, to Todd Carper, System and Method for Installing /De-Installing an Application on A Smart Card.
- Patent No. 6,488,211, to David B. Everett, System and Method for Flexibly Loading in IC Card.

16. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

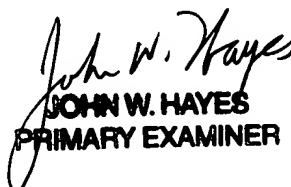
(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

**Abdi/K
June 9, 2003**


**JOHN W. HAYES
PRIMARY EXAMINER**